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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 5709**
Koichi HIRANO et al. : Docket No. 2003_1690A
Serial No. 10/726,675 : Group Art Unit 2831
Filed December 4, 2003 : Examiner Nguyen T. Ha

CAPACITOR AND METHOD FOR PRODUCING
THE SAME, AND CIRCUIT BOARD WITH A
BUILT-IN CAPACITOR AND METHOD
FOR PRODUCING THE SAME

THE COMMISSIONER IS AUTHORIZED
TO CHARGE ANY DEFICIENCY IN THE
FEE FOR THIS PAPER TO DEPOSIT
ACCOUNT NO. 23-0975.

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In the Office Action dated December 17, 2004, the Examiner identified the present application as containing claims directed to five distinct species. The Examiner has required the Applicants to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted. The Examiner believes that no claims are generic.

Because Applicants are required to elect one of the species enumerated by the Examiner, Applicants elect Species I, with **traverse**, on which claims 1-8 are readable.

Applicants, however, would like to bring to the Examiner's attention MPEP 806.04(f) which sets forth the test for determining when a restriction to different species is proper. In particular, this section sets forth that a restriction to different species is proper when "one claim recites limitations which under the disclosure are found in a first species but not in a second,

while a second claim recites limitations disclosed only for the second species and not the first” (emphasis added). This is frequently expressed by saying that claims to be restricted to different species must recite mutually exclusive characteristics of such species.

In the Office Action, the Examiner has indicated that Figs. 1-7 (claims 1-8) correspond to Species I, that Figs. 8-10 (claims 9-25) correspond to Species II, that Figs. 14-15 (claims 26 and 27) correspond to Species III, that Figure 16 (claims 28-30) corresponds to Species IV, and that Figs. 11a-11d (claims 31-51) correspond to Species V.

Regarding claim 1, Applicants note that this claim is drawn to a capacitor which recites features such as “a valve metal element for an anode including a capacitor forming part and an electrode lead part”, “a dielectric oxide film provided on a surface of the valve metal element for an anode”, “a solid electrolyte layer provided on the dielectric oxide film” and “a charge collecting element for a cathode provide on the solid electrolyte layer”.

Regarding claim 9, Applicants note that this claim is drawn to a circuit board with a capacitor and recites features drawn to the capacitor such as “a valve metal element for an anode including a capacitor forming part and an electrode lead part”, “a dielectric oxide film provided on a surface of the valve metal element for an anode”, “a solid electrolyte layer provided on the dielectric oxide film” and “a charge collecting element for a cathode provide on the solid electrolyte layer”.

As is evident from a comparison between claims 1 and 9, it is clear that all of the limitations recited in claim 1 are also recited in claim 9. Accordingly, Applicants respectfully submit that claim 1 does not recite limitations which under the disclosure are found in the first

species but not in the second species. That is, claims 1 and 9 do not recite mutually exclusive characteristics, and therefore, these claims cannot be included in separate species.

Applicants note that the same analysis with respect to claim 9 also holds for claims 26, 28 and 29. That is, all of the limitations that are recited in claim 1 are also recited in each of these claims. Accordingly, Applicants respectfully submit that Species I-IV should correspond to a single species, and therefore, request that claims 1-30 be examined on the merits.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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